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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,510	12/14/2001	Syunji Sugaya	P/2850-53	4552
2352 7590 06/02/2010 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER BOVEJA, NAMRATA				
ART UNIT		PAPER NUMBER		
3622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/018,510

Applicant(s)

SUGAYA, SYUNJI

Examiner

NAMRATA BOVEJA

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 1-63, 65-68, 70 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64, 69, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 73 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the RCE communication filed on 05/11/2010.
2. Claims 1-63, 65-68, and 70 have been cancelled. Claims 64, 69, and 71-72 are presented for examination. Claim 73 has been withdrawn from consideration.
3. Amendments to claims 64 and 71-72 have been entered and considered.

Election/Restrictions

4. *Newly submitted claim 73 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:*
 - I. *Claims 64, 69, and 71-72, drawn to an advertising presentation system comprising: a server connected to a network; an advertisement server distributing an advertisement; and a user side equipment that presents the advertisement received from the advertisement server while conducting an operation of transmitting/receiving data to/from the server via the network, wherein, the user side equipment calculates a time necessary for presenting the advertisement up to the end based on a size of advertisement data and, based on a transmission speed of a communication line and a size of target data, adjusts a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time, and wherein a portion of the target data is not downloaded to the user side equipment before end of reproduction of the advertisement, classified in class 705, subclass 14 and class 709, subclass 219.*
 - II. *Claim 73, drawn to an advertisement presentation system comprising: a server connected to a network; an advertisement server distributing an advertisement; and*

a user side equipment that presents the advertisement received from the advertisement server while conducting an operation of transmitting/receiving data to/from the server via the network, wherein the user side equipment, if target data is downloaded before reproduction of the advertisement finishes, by utilizing a remaining time until reproduction of the advertisement finishes, downloads other target data in accordance with a user's request, classified in class 705, subclass 14 and class 709, subclass 219.

5. *Inventions of groups I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group II has separate utility such as the user side equipment, if target data is downloaded before reproduction of the advertisement finishes, by utilizing a remaining time until reproduction of the advertisement finishes, downloads other target data in accordance with a user's request, which does not involve the user side equipment calculating a time necessary for presenting the advertisement up to the end based on a size of advertisement data and, based on a transmission speed of a communication line and a size of target data, adjusting a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time, and wherein a portion of the target data is not downloaded to the user side equipment before end of reproduction of the advertisement. See MPEP § 806.05(d).*

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 73 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 64 and 69-72 are rejected under U.S.C. 103(a) as being unpatentable over Gilmore et al (European Patent Application Number EP 0875843 hereinafter Gilmore) in view of Aharoni et al. (Patent Number 6,014,694 hereinafter Aharoni).

In reference to claim 64, Gilmore teaches an advertisement presentation system comprising: a server connected to a network (page 3 lines 9-35); an advertisement server distributing an advertisement (page 4 lines 5-56); and a user side equipment *that* presents the advertisement received from the advertisement server while conducting an operation of transmitting/receiving data to/from the server via the network (page 2 lines 43-48 and page 4 lines 5-56), wherein, the user side equipment calculates a time necessary for presenting the advertisement up to the end based on a size of advertisement data and, based on a transmission speed of a communication line and a size of the target data (page 2 lines 46-48 and page 4 lines 29-56), *and wherein a*

portion of the target data is not downloaded to the user side equipment before end of reproduction of the advertisement (i.e. the ad is replayed and therefore has been reproduced at least once until the target page has been loaded) (page 4 lines 40-41).

Gilmore does not specifically teach adjusting a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time. Aharoni teaches adjusting a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time (abstract, col. 2 lines 11-24, col. 3 lines 62 to col. 4 lines 34, col. 6 lines 61 to col. 7 lines 6, and col. 11 lines 25-44). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Gilmore to include user side equipment that is effective to adjust a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time to efficiently use available network bandwidth and to effectively use the opportunity presented by the existence of idle time while also maximizing advertising revenues.

7. In reference to claim 69, Gilmore teaches an advertisement presentation system wherein, said size of the advertisement data is a file size of the advertisement data (page 2 lines 46-48 and page 4 lines 29-56).

8. In reference to claim 71, Gilmore teaches an advertisement presentation system wherein, said portion of the target data is downloaded to the user side equipment after reproducing the advertisement (i.e. target data is displayed to the user after the advertisement has been displayed) (page 2 lines 46-48 and page 4 lines 29-41).

9. In reference to claim 72, Gilmore teaches an advertisement presentation system wherein, the user side equipment downloads the portion of the target data by using a URL, received from the advertisement server (page 4 lines 5-56).

Response to Arguments

10. After careful review of Applicant's remarks/arguments filed on 05/11/2010, the Examiner fully considered the arguments, but they are moot in view of the new ground(s) of rejection. Amendments to claims 64 and 71-72 have been entered and considered.

11. Newly added claim 73 is subject to a restriction requirement as explained in the Office Action above.

12. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197.

/NAMRATA BOVEJA/

Primary Examiner, Art Unit 3622